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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,277	07/14/2000	KLAUS-DIETER HAMMER	051009/0125	1514

22428 7590 01/03/2007  
FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/600,277

**Applicant(s)**

HAMMER ET AL.

**Examiner**

Alicia Chevalier

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-16 and 18-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 and 18-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **RESPONSE TO AMENDMENT**

1. Claims 13-16 and 18-44 are pending in the application, claims 1-12 and 17 have been cancelled.
2. Amendments to the specification and the claims, filed on October 2, 2006, have been entered in the above-identified application.

### ***REJECTIONS REPEATED***

3. The 35 U.S.C. §103 rejection of claims 13, 14, 16 and 18-44 as over Hammer et al. (US Patent No. 5,928,737) in view of Voigt et al. (US Patent No. 5,936,014) is repeated for reasons previously made of record in office action June 1, 2006, pages 2-5, paragraph #3.
4. The 35 U.S.C. §103 rejection of claim 15 as over Hammer et al. (US Patent No. 5,928,737) in view of Voigt et al. (US Patent No. 5,936,014) is repeated for reasons previously made of record in office action June 1, 2006, pages 5-6, paragraph #4.
5. The 35 U.S.C. §103 rejection of claims 13, 14, 16 and 18-44 as over Hammer et al. (US Patent No. 5,928,737) in view of Bastioli et al. (US Patent No. 5,801,207) is repeated for reasons previously made of record in office action June 1, 2006, pages 6-8, paragraph #5.
6. The 35 U.S.C. §103 rejection of claim 15 as over Hammer et al. (US Patent No. 5,928,737) in view of Bastioli et al. (US Patent No. 5,801,207) is repeated for reasons previously made of record in office action June 1, 2006, pages 8-9, paragraph #6.

***NEW REJECTIONS***

7. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Specification***

8. The amendment filed October 2, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: anhydrite. Applicant does not have support to switch “anhydrite” to “anhydrite”.

Applicant is required to cancel the new matter in the reply to this Office Action.

***ANSWERS TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments in the response filed October 2, 2006 regarding the 35 U.S.C. §103 rejection over Hammer in view of Voigt of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Hammer does not disclose or contemplate any of the specific synthetic polymers set forth in instant claim 13. Applicant further argues that the specific polymers of claim 13 render the casing resistant to boiling water, since they form a matrix which protects the starch from being dissolved.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is noted the limitation “resistant to boiling water” is not in claim 13. Independent claim 42 recites “wherein the food casing remains stable on exposure to hot water” and independent claim 44 recites “wherein component b is present in an amount sufficient to render the food casing stable on exposure to hot or boiling water.” The limitation “hot” is a relative term. It is unclear exactly what temperature range that Applicant desires the casing to be resistant too. Therefore, the casing of the combination of Hammer and Voigt is deemed to be “resistant to hot water,” since the limitation is a functional limitation and is deemed to be a latent property of the prior art since the prior art is substantially identical in composition and/or structure. MPEP 2145 (II). Furthermore, Applicant has not provided any evidence that the casing of the combination of Hammer and Voigt is not resistant to hot water.

In response to applicant's argument that Hammer and Voigt are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are concerned with packing for ingestible products, i.e. food and tobacco.

10. Applicant's arguments in the response filed October 2, 2006 regarding the 35 U.S.C. §103 rejection over Hammer in view of Bastioli of record have been carefully considered but are deemed unpersuasive.

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In response to applicant's argument that Hammer and Bastioli are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are concerned with packing materials.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

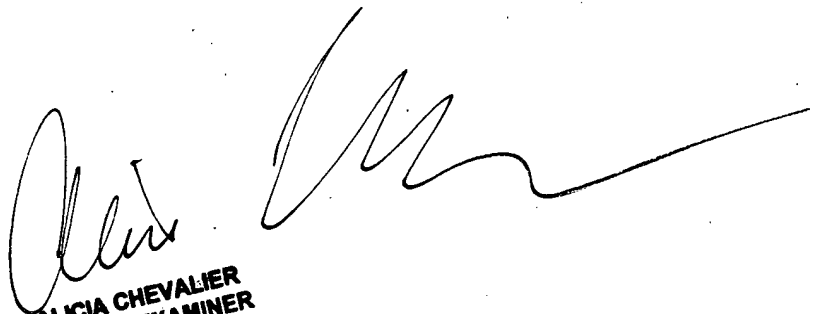
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ac

12/26/06

  
**ALICIA CHEVALIER  
PRIMARY EXAMINER**